

Application No. 10/725,279
Attorney Docket No. 07783-0114

Office Action, the Examiner believes that "[I]n the instant case the product can be made be [sic] molding a solid ceramic fiber containing ceramic matrix and boring a hole and channel therein."

If the restriction is maintained, Applicant requests that this proposed boring process be clarified. To the extent that Applicant can interpret the Examiner's reasoning, the Examiner must be aware of boring technology that is unknown to Applicant. Applicant knows of no boring technology that can replicate the configuration of a channel left in a ceramic matrix composite when a fugitive thread is sintered. A thread is by its very nature flexible and therefore can be configured to leave a non-linear channel. Drills, lasers, and other known boring technologies create only linear holes and channels. Applicant directs the Examiner's attention to Specification paragraph 0003, wherein the limitations and shortcomings of prior art drilling are discussed.

Moreover, it is abundantly clear that no known boring technology can create the same article as claimed by Applicant when one considers Applicant's claimed process wherein the fugitive thread is stitched through the ceramic cloth plies. As explained by Applicant in the specification (at Paragraph 0017, for example) stitching creates a grid of connected holes and channels that run not only through plies, but also along plies between holes. Sintering the stitched thread thus makes holes through the ceramic cloth, as well as channels connecting the holes. No boring technology known to Applicant can produce such holes and connected channels. Moreover, as explained in Paragraph 0017, where the stitched ply is sandwiched with other plies, the holes and channels created upon sintering are blind. Applicant knows of no drilling or other boring technology that can create such internal blind holes and channels in a composite article. Applicant respectfully requests the Examiner to provide details of any such boring technology known to the Examiner. Otherwise, the Examiner's statement does not factually support the restriction, and the restriction must be withdrawn.

(2) Second, by separately classifying the process and product, the Examiner may be asserting that the process and product have acquired separate status in the art, based upon different patent office classifications. To the extent that the Examiner relies on such assertion, Applicant respectfully disagrees with the propriety of such an assertion in this case. Patent office art classifications are administrative conveniences developed in the patent office. There

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has been no showing that they bear any relation to the manner in which those skilled in the art view the art. Hence, there is no support for an assertion that the process and product have acquired a separate status in the art. If the Examiner intends to rely upon this concept of separate status in the art to support the restriction, Applicant asks that the Examiner set forth the factual basis to demonstrate that those skilled in the art, rather than those who establish the patent office classification system, would view the article and the method as having acquired separate status.

(3) Third, there is no undue burden placed on the patent office by examining all of the claims of Groups I and II. The different patent office classifications simply mean that the claims might otherwise be referred to different examining groups--it does not mean that an examiner in either examining group should not perform a search covering both art classifications. To conduct a proper examination of the claims of either Group, the art of both class 264, and class 428, subclass 137 must be searched to meet the thoroughness requirement of the rules, because these classes/subclasses have now been recognized by the Examiner to include relevant art. The art class dealing with a method may contain a reference that incidentally discusses a final structure that is pertinent to the present invention, and the art class dealing with an article may contain a reference that incidentally discusses a pertinent method. The rules provide:

"On taking up an application for examination or a patent in a reexamination proceeding, the Examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated. [37 CFR 1.104(a)].

There has been no showing that a search of these two art classes/subclasses would pose a serious burden on the Examiner, and both should be searched. Multiple art classes/subclasses are routinely searched when applications are examined, and there is no reason that all of the art

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classes/subclasses identified by the Examiner as relevant cannot be searched in this case. MPEP 803 states:

"If the search and examination of the entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." [Emphasis added]

Given that 37 CFR 1.104(a) mandates a thorough examination, which would presumably include searching in both art classes, the mandate of MPEP 803 requires that both inventions be examined. If the restriction is maintained, Applicant asks that the Examiner demonstrate why a search of both classes/subclasses would pose a serious burden, and in fact why both classes/subclasses should not be searched to meet the thoroughness requirement. Applicant wants a thorough search of its invention, and is concerned that the search may be less than thorough if certain search classes are arbitrarily excluded for restriction reasons.

(4) Fourth, the restriction is made pursuant to 35 USC §121. The claims must be shown to be "independent and distinct" to maintain the restriction, 35 USC §121, 37 CFR 1.141, MPEP 802. Since this requirement is statutory, it is not proper to interpret the statute in any other fashion. 35 USC 121 provides no basis for restriction on the ground that the patent office has classified the inventions of the various claims into different art classifications and search fields. In this case, the claims are neither independent nor distinct.

The restriction asserts that the inventions are "distinct", but does not address the question of whether the inventions of Groups I and II are "independent", as required by the statute, the regulation, and the MPEP. Applicant submits that the inventions of Groups I and II are not "independent". The term "independent" is defined in MPEP 802.01:

"The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect..."

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The restriction can be made only "If it can be shown that the two or more inventions are in fact independent...", MPEP 806.04.

As made quite clear in the specification, the subject matter of Groups I and II are not "independent". Specifically, the disclosed relationship is that of a product and a method for making the product using a related approach.

The inventions are also not distinct. MPEP 806.05(f) provides that the inventions are distinct if " ... the process as claimed can be used to make other and different products." (emphasis in MPEP) The present argument of distinctness relies on this provision of the MPEP. For the reasons stated above in relation to point (1), the hypothetical process that is said to produce the same product does not support the restriction.

For these reasons, the claims are not "independent and distinct". They are neither, and therefore should be examined in the same application, pursuant to the various statutes, regulations, and MPEP sections set forth herein. Applicant asks that the Examiner reconsider and withdraw the restriction requirement as to Groups I and II.

CONCLUSION

Applicant requests a prompt and favorable action by the Examiner. If the Examiner believes that prosecution of this Application could be expedited by a telephone conference, the Examiner is encouraged to contact the Applicant.

The Commissioner is hereby authorized to charge any additional fees and credit any overpayments to Deposit Account No. 50-1059.

Respectfully submitted,
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By



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